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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,171	10/31/2001	Horst Hoeffkes	H 3294 PCT/US	9789

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EXAMINER

ELHILO, EISA B

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,171

Applicant(s)

HOEFFKES ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 14-30 are pending in this application.

DETAILED ACTION

Claim Objections

1. Applicant is advised that should claim 14 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: a method for coloring keratin fibers.

Claim Rejections - 35 USC § 102

3 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-16, 19, 21-24, 26-28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Moeller et al. (WO 95/24886).

Moeller (WO' 886) teaches a method for dying hair comprising applying to the hair a dyeing composition comprising 2,4,5,6-tetraaminopyrimidine compound as claimed in claims 15, 16, 27 and 28 which represented the claimed formula (I), when in the claimed formula R1,

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R2, R3 and R4 denote NH₂ groups as claimed in claims 14 and 26, a pyridine derivatives such as 2,6-dimethoxy-3,5-diaminopyridine which represented the claimed formula (VII), when in the claimed formula (VII), R16 and R17 are both denote methoxy (OCH₃) groups and 1,3-bis(2,4-diaminophenoxy)propane as claimed in claims 19 and 30 and 4,4'-diaminodiphenylamine as claimed in claim 23 (see page 18 and 19, Table 1), 5,6-dihydroxyindole as claimed in claim 22 (see page 12, line 6). The composition further, comprises carbonyl compound such as N-allyl istatin as claimed in claim 21 (see page 13, line 10) and surfactants such as anionic and nonionic surfactants as claimed in claim 24 (see page 11, line 13). Moeller also teaches that the composition is oxidizable in air as claimed in claim 14 step (B) (see page 12, lines 6-7). Moeller teaches all the limitations of the instant claims. Hence Moeller anticipates the claims.

Claim Rejections - 35 USC § 103

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-20 and 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al. (WO 98/38175).

Rose (WO, 175) teaches a method for coloring keratin fibers. The method comprises applying to the hair as keratin fibers a composition comprising pyrimidine derivatives such as 2,4,5,6-tetraaminopyrimidine as claimed in claims 15, 16, 27 and 28 (see page 6, lines 4-5) which represented the claimed formula (I), when in the claimed formula R1, R2, R3 and R4 denote NH₂ groups as claimed in claims 14 and 26 step (A), m-phenylenediamine compound

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which represented the claimed formula (III), when in the claimed formula (III), R7, R8, R10 and R11 denote hydrogen atoms (see page 6, line 20) 1,3-bis(2,4-diaminophenoxypropane) as claimed in claims 19 and 30 (see page 7, lines 1-2), 5,6-dihydroxyindole as claimed in claim 22 (see page 8, lines 11), p-phenylenediamine as claimed in claim 23 (see page 6, line 1), surfactants such as anionic, cationic or nonionic surfactants as claimed in claim 24 (see page 9, 16-17). Rose also teaches oxidation bases (primary intermediates) and couplers (secondary intermediates) in the amounts of 0.005 to 20% by weight, based on the colorant composition as a whole, which is overlapped with the claimed amounts as claimed in claims 17 and 20 (see page 7, lines 10-12). Rose further, teaches that the coloring process may be carried out with enzymes as claimed in claim 25 (see page 16, lines 1-7).

The claims differ from the reference by reciting pyrimidine derivatives in combination with at least one compound selected from the claimed compounds to form a composition for coloring keratin fibers. Further, the reference fails to teach the m-phenylenediamine compound of the claimed formula (III), in which at least one of R7 and R8 is a C1 to C4 alkyl group or a C1 to C4 hydroxyalkyl group as claimed in claims 18 and 29. Further, the reference fails to teach the pyridine derivatives of the claimed formula (VIII), in which R20 is hydrogen or a C1 to C4 alkoxy group as claimed in claims 18 and 29.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply to the hair such a colorant composition with a reasonable expectation of success because the reference teaches all of the colorant ingredients that recited in the instant claims, and, thus, a person of ordinary skill in the art would be motivated to select any

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combination of these colorant ingredients including those claimed in a process for coloring hair in the absence of contrary.

With regards to claims 18 and 29 it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply to the hair a composition comprising m-phenylenediamine compound in which the hydrogen atoms of the amino groups are substituted with alkyl radicals with a reasonable expectation of success because the reference teaches m-phenylenediamine derivatives (see page 2, line 15), and, thus, a person of the ordinary skill in the art would expect that any species of the genus that taught by the reference including those claimed should have similar properties and thus, the same use as the genus as a whole, absent, unexpected results. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply to the hair a composition comprising the pyridine species of the claimed invention with a reasonable expectation of success because the reference teaches the equivalence between the species of the pyridine derivatives such as 2,6-dihydroxypyridine in which position 6 is occupied with a hydroxyl radical, 2,6-diaminopyridine in which position 6 is occupied with a amino radical, 2-amino-3-hydroxypyridine in which position 6 is occupied with a hydrogen atom and 3-amino-2-methyamino-6-methoxypyridine in which position 6 is occupied with a methoxy radical (see page 6, lines 23-30), and, thus, a person of the ordinary skill in the art would expect that any species of the genus including those claimed should have similar properties and thus, the same use as the genus as a whole, absent, unexpected results.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Examiner Eisa Elhilo
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July 14, 2003